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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/721,138

11/25/2003

Robert P. Loe

D/A3568

2082

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EXAMINER

DANG, DUY M

ART UNIT

PAPER NUMBER

2624

MAIL DATE

DELIVERY MODE

06/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/721,138	<b>Applicant(s)</b> LOCE ET AL.	
	<b>Examiner</b> Duy M. Dang	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/17/06 &amp; 11/29/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. Color photographs and color drawings and a petition filed under 37 CFR 1.84(a)(2) have been made of record. The decision has not been made.

### *Specification*

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 7,136,522 (referred as the patent '522 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as follows:

As to claim 1 as a representative claim, this claim 1 of the instant application is a broader recitation of the invention and the claim 1 of the patent '522 covers the equivalent subject matter

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as that of claim 1 of the instant application. Specifically, each limitation of claim 1 of the instant application is set forth in claim 1 of the patent '522. For example, patented claim 1 teaches:

*“receiving...composite image”* in lines 1-4; *“rendering the composite image...colorants”* in lines 5-6; and *“recovering...color image”* in lines 7-15. While the patented claim 1 includes additional

limitations not set forth in claim 1 of the instant application, the use of transitional term

*“comprising”* in the instant claim 1 fails to preclude the possibility of additional elements.

Therefore, claim 1 of the instant application fails to define an invention that is patentably distinct from claim 1 of the patent '522. Likewise, claim 11 of the instant application fails to define an invention that is patentably distinct from claim 12 of the patent '522.

Each of dependent claims 2-10 and 12-35 of the instant application is also defined by the claims 2-11 and 13-19 of the patent '522 so that these claims 2-10 and 12-35 of the instant applicant also fail to define a patentably distinct invention.

5. Claims 1-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,155,068 (referred as the patent '068 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as follows:

As to claim 1 as a representative claim, this claim 1 of the instant application is a broader recitation of the invention and the claim 1 of the patent '068 covers the equivalent subject matter as that of claim 1 of the instant application. Specifically, each limitation of claim 1 of the instant application is set forth in claim 1 of the patent '068. For example, patented claim 1 teaches:

*“receiving...composite image”* in lines 1-6; *“rendering the composite image...colorants”* in lines 7-8; and *“recovering...color image”* in lines 9-14. While the patented claim 1 includes additional

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limitations not set forth in claim 1 of the instant application, the use of transitional term “comprising” in the instant claim 1 fails to preclude the possibility of additional elements. Therefore, claim 1 of the instant application fails to define an invention that is patentably distinct from claim 1 of the patent ‘068. Likewise, claim 11 of the instant application fails to define an invention that is patentably distinct from claim 12 of the patent ‘068.

Each of dependent claims 2-10 and 12-35 of the instant application is also defined by the claims 2-11 and 13-18 of the patent ‘068 so that these claims 2-10 and 12-35 of the instant applicant also fail to define a patentably distinct invention.

### ***Conclusion***


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M. Dang whose telephone number is 571-272-7389. The examiner can normally be reached on Monday to Friday from 6:00AM to 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Eileen D. Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dmd  
6/07



**DUY M. DANG**  
**PRIMARY EXAMINER**